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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,987	07/31/2003	Gregory T. Hulan	10991815-3	2196

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EXAMINER

POON, KING Y

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/631,987	Applicant(s) HULAN, GREGORY T.	
	Examiner King Y. Poon	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9 and 12-29 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9,12-17,19-25 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-5, 12-17, 19, 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1: The limitation of "scaling first copies of the scanned image to a first selected photo size and scaling copies of the scanned image to a second selected photo size, the means also cause the print module to print first copies of the scanned image on a first sheet and to print the second copies of the scanned image on a second sheet" is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

According to page 5, lines 1-13, 106-108, fig. 5, of applicant's disclosure, the scanned image of a first selected photo size is different from the scanned image of a second selected photo size. The image of an original is being scanned multiple times to create the scaled images. The way the claim is written appears the system scans the

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image one time and scaled the scanned image to a first selected photo size and to a second selected photo size.

Claims 3-5, 12-17, 19 are rejected under 35 U.S.C. 112, first paragraph because they depend on rejected claim 1.

Claims 14, 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "prompts for different standard photo sizes correspond to maximum printable area on a sheet" is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-7, 9, 12-17, 19-25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jamzadeh (US 4,994,827) in view of Suzuki (US 4,706,099).

Regarding claim 1: Jamzadeh teaches an apparatus (column 3, lines 50-65) for scanning an image (column 4, lines 15-25) and printing copies of the image on a sheet (e.g., fig. 4), the apparatus comprising: a scan module (column 4, lines 15-25); a print module (column 4, lines 43-48); an input device (control panel, column 4, lines 35-40) for allowing a plurality of different standard photo size to be selected; and means (control unit of column 4, lines 30-35) for causing the scan module to scan the image from an original (column 4, lines 17-20), the means generates first copies (column 5, lines 1-15) of the scanned image to a first selected photo size, and generating second copies of the scanned image (the another time the user selected to print, Jamzadeh's invention can be used multiple times) the to a second selected photo size, the means also causing the print module to print first copies of the scanned image on a first sheet and to print the second copies of the scanned image on a second sheet (e.g., fig. 3, fig. 4).

Jamzadeh is silent regarding determining the size of the scanned image and performing a scaling process on the scanned image to the selected photo size.

However, Jamzadeh, column 2, lines 17-32, teaches the system of Suzuki, which teaches determining the size of the scanned image and performing a scaling process on the scanned image to the selected photo size (column 6, lines 30-57, column 2, lines 33-50, Suzuki, form the scanned image generating/determining the image size such that a thinning processed or an enlargement processed would be performed on the scanned image).

Since Jamzadeh already points out to a person with ordinary skill in the art the reference of Suzuki which deal with how the printed image data is generated from the scanned image data, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Jamzadeh to include: determining the size of the scanned image and performing a scaling process on the scanned image to the selected photo size, as taught by Suzuki.

The reason of doing so would have allowed the photograph to be accurately regenerated. A person with ordinary skill in the art would easily related to the fact that an image of 2X2 inches would not be printed as a 4X6 and 11X17, (fig. 1, Jamzadeh) without scaling; i.e., modified the size of the scanned image to create the image with the user selected size to be printed.

Jamzadeh also does not teach to scan an original of any size (any size is being interpreted as different sizes that is capable of being scanned by the scanner, no scanner can scan infinite size) although all scanner inherently scans image of different sizes.

Such limitation is being taught by Fukushi (column 5, lines 20-35, column 1, lines 49-49).

Therefore, it would have been obvious to person with ordinary skill in the art at the time the invention was made to scan an original of any size such that photograph of different size would be regenerated as taught by Fukushi, column 1, lines 43-50.

Regarding claim 3: Jamzadeh teaches rotates (fig. 4) at least one copy to utilize maximum printable area on the first or second sheet.

Regarding claim 4: Jamzadeh teaches wherein the input device is configured to prompt for different standard photo sizes (column 4, lines 35-40).

Regarding claim 5: Jamzadeh teaches wherein set of standard photo sizes are programmably stored in the means (column 4, lines 35-40, inherent in the system of Suzuki).

Regarding claim 6: Jamzadeh teaches an apparatus (column 3, lines 50-65) for scanning an image (column 4, lines 15-25) and printing copies of the image on a sheet (e.g., fig. 4), the apparatus comprising: a scan module (column 4, lines 15-25); a print module (column 4, lines 43-48); an input device (control panel, column 4, lines 35-40) for allowing a plurality of different standard photo size to be selected; and a controller (control unit of column 4, lines 30-35) for causing the scan module to scan the image from an original (column 4, lines 17-20), the controller generates first scanned image copies (column 5, lines 1-15) that are scaled to a first selected photo size and that are positioned to utilize maximum printable area on a first sheet (column 3, lines 1-5), and generating second scanned image copies (the another time the user selected to print, Jamzadeh's invention can be used multiple times) that are scaled to a second selected photo size and that are positioned to utilize maximum printable area on a second sheet (column 3, lines 1-5), and causing the print module to print first copies of the scanned image on a first sheet and to print the second copies of the scanned image on a second sheet (e.g., fig. 3, fig. 4).

Jamzadeh is silent regarding determining the size of the scanned image and performing a scaling process on the scanned image to the selected photo size.

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However, Jamzadeh, column 2, lines 17-32, teaches the system of Suzuki, which teaches determining the size of the scanned image and performing a scaling process on the scanned image to the selected photo size (column 6, lines 30-57, column 2, lines 33-50, Suzuki, form the scanned image generating/determining the image size such that a thinning processed or an enlargement processed would be performed on the scanned image).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Jamzadeh to include: determining the size of the scanned image and performing a scaling process on the scanned image to the selected photo size, as taught by Suzuki.

The reason of doing so would have allowed the photograph to be accurately regenerated. A person with ordinary skill in the art would easily related to the fact that an image of 2X2 inches would not be printed as a 4X6 and 11X17, (fig. 1, Jamzadeh) without scaling; i.e., modified the size of the scanned image to create the image with the user selected size to be printed.

Jamzadeh also does not teach to scan an original of any size (any size is being interpreted as different sizes that is capable of being scanned by the scanner, no scanner can scan infinite size) although all scanner inherently scans image of different sizes.

Such limitation is being taught by Fukushi (column 5, lines 20-35, column 1, lines 49-49).

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Therefore, it would have been obvious to person with ordinary skill in the art at the time the invention was made to scan an original of any size such that photograph of different size would be regenerated as taught by Fukushi, column 1, lines 43-50.

Regarding claim 7: Jamzadeh teaches wherein the apparatus is an all in one machine (column 3, lines 50-55).

Regarding claim 9: Jamzadeh teaches wherein the input device is configured to prompt for additional standard photo sizes (column 4, lines 35-40).

Regarding claim 12: Suzuki teaches wherein the means of Jamzadeh that causing the print module to print the first and second copies of the scanned image on the first and second sheets uses a single resolution for printing photograph (column 1, lines 65-68).

Regarding claim 13: Suzuki teaches wherein the means of Jamzadeh that causing the print module to print the first and second copies of the scanned image on the first and second sheets uses a single resolution for printing photograph (column 1, lines 65-68). Jamzadeh teaches uses mixed color dots to create colors (column 3, lines 50-65).

Regarding claim 14: Jamzadeh teaches wherein the prompts for different standard photo sizes correspond to maximum printable area on a sheet (column 5, lines 1-30, column 3, lines 1-5, column 4, lines 35-40).

Regarding claims 15, 16: Jamzadeh does not teach the photo size is measured in metric and English.

Fukushi teaches standard printed size of a photograph are in metric/English unit of measure (column 6, lines 50-55, Fukushi; metric is a kind of English unit of measure because text book published in English to be used by the students includes metric system as units of measure).

Therefore it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Jamzadeh such that the photo size is measured in metric and English.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Jamzadeh by the teaching of Fukushi because it would have allowed Jamzadeh's system to be widely usable in different countries.

Regarding claim 17: Fukushi teaches wherein the original is a photograph such that photographs would be reproduced, or other user desired print product would be generated from user's printed photograph, column 1.

Regarding claim 19: Jamzadeh teaches wherein the apparatus is a digital copying machine (column 7, lines 50-55, fig. 1).

Regarding claim 20: Suzuki teaches wherein the means of Jamzadeh that causing the print module to print the first and second copies of the scanned image on the first and second sheets uses a single resolution for printing photograph (column 1, lines 65-68).

Regarding claim 21: Suzuki teaches wherein the means of Jamzadeh that causing the print module to print the first and second copies of the scanned image on

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the first and second sheets uses a single resolution for printing photograph (column 1, lines 65-68). Jamzadeh teaches uses mixed color dots to create colors (column 3, lines 50-65).

Regarding claim 22: Jamzadeh teaches wherein the input device includes a set of entries for different standard photo sizes correspond to maximum printable area on a sheet (column 5, lines 1-30, column 3, lines 1-5, column 4, lines 35-40).

Regarding claims 23, 24: Jamzadeh does not teach the photo size is measured in metric and English.

Fukushi teaches standard printed size of a photograph are in metric/English unit of measure (column 6, lines 50-55, Fukushi; metric is a kind of English unit of measure because text book published in English to be used by the students includes metric system as units of measure).

Therefore it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Jamzadeh such that the photo size is measured in metric and English.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Jamzadeh by the teaching of Fukushi because it would have allowed Jamzadeh's system to be widely usable in different countries.

Regarding claim 25: Fukushi teaches wherein the original is a photograph such that photographs would be reproduced, or other user desired print product would be generated from user's printed photograph, column 1.

Regarding claim 29: Jamzadeh teaches wherein the apparatus is a digital copying machine (column 7, lines 50-55, fig. 1).

Response to Arguments

5. Applicant's arguments (regarding prior art rejection) with respect to claims 1, 3-7, 9, 12-17, 19-25, 29 have been considered but are moot in view of the new ground(s) of rejection. Please see detailed office action.

With respect to applicant's argument that because: it is inherent that a standard letter sized sheet has a maximum printable area, physical size limitation dictate that only 9 wallet sized images can fit within that area; thus, specification describes prompts for the various standard photo sizes wherein those prompts correspond to a maximum printable area on a sheet; has been considered.

The examiner cannot follow the reasoning. The examiner sees the specification describe "those images are printed correspond to a maximum printable area on a sheet." The examiner does sees "those prompts correspond to a maximum printable area on a sheet."

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 1, 2006

A handwritten signature in black ink, appearing to read 'K. Y. Poon', with a stylized flourish at the end.

KING Y. POON
PRIMARY EXAMINER